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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,518	10/17/2001	Jean-Marc Wanner	NY-GRYN 204-US	7690
24972	7590	03/16/2006		
FULBRIGHT & JAWORSKI, LLP 666 FIFTH AVE NEW YORK, NY 10103-3198			EXAMINER PHAM, TUAN	
			ART UNIT	PAPER NUMBER
			2643	

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/981,518

Applicant(s)

WANNER, JEAN-MARC

Examiner

TUAN A. PHAM

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-9 and 12-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-9, and 12-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 01/20/2006 have been fully considered but they are not persuasive.

In response to applicant's remark on pages 5-7, Applicant argues that there is hindsight to combine of Chang's reference with Jensen's reference.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Chang disclose a telephone for automatically detecting the outgoing call number and the incoming call number and compare that number stored in the memory. On the other hand, Jensen disclose a telephone monitoring apparatus for automatically monitoring and recording incoming and outgoing telephone call to provide an automatic recording of telephone call parameters such as time and duration of the call number dialed or received. Both Chang and Jensen disclose the telephone monitoring apparatus for monitoring the incoming call and outgoing call on the single line, and the

apparatus can be use at home or small office. Therefore, the combination of Chang and Jensen are proper, and it is not hindsight as arguing by applicant.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the reference. Rather, the test is what the combined teaching of the references would have suggested to those of ordinary skill in the art. Therefore, the motivation to do so found in the reference themselves to incorporate the teaching of Chang into view of Jensen in order to prevent the misidentification of a call may result in lost billing opportunities or expense deductions as suggested by Jensen at column 1, lines 50-55.

In response to applicant's arguments against the references Jensen individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed.

Cir. 1986). Examiner only uses the teaching of Jensen to incorporate with Chang's reference, not only Jensen as the main reference.

Base on the above rational, it is believed that the claimed limitations are met by the combination of Chang and Jensen and therefore, the rejection are still maintained.

Claim Objections

2. Claim 4 is objected to because of the following informalities: Claim 3 has been canceled, claim 4 cannot depend on claim 3. For a purpose of examination, the examiner is assumed that claim 4 is depending on claim 1. Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-2, 4-9, and 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al. (U.S. Patent No.: 5,838,777, hereinafter, "Chang") in view of Jensen (6,373,934).**

Regarding claim 1, Chang teach a telephone comprising (see figure 2, col.2, ln.39-41):

a memorization or indication device for memorizing or indicating data related to incoming and/or outgoing calls on a telephone line (see figure 2, memory 24, LCD 25, col.1, ln.30-36, col.2, ln.47-65);

a detector for outputting a line state signal (the host telephone go off-hook and display the answered on the LCD 25) of the telephone line to the memorization or indication device (see figure 2, FSK decoder 21, col.2, ln.47-67), and

wherein the memorization or indication device is operable to memorize or indicate the data as a function of the line state signal of the telephone line (the host telephone go off-hook, on-hook, and display the answered on the LCD 25), thereby providing reliable data (read on caller ID) even when calls originate or terminate from or on another telephone on the telephone line (see col.2, ln.47-55).

It should be noticed that Chang fails to teach the line state of the telephone is either a busy state or a free state, wherein the memorization device is operable to memorize communication times of incoming calls by determining time elapsed between two line state changes for each incoming call. However, Jensen teaches the line state of the telephone is either a busy state or a free state (read on off-hook or on-hook, col.3, ln.10-16), wherein the memorization device is operable to memorize communication times of incoming calls by determining time elapsed between two line state changes for each incoming call (see figure 2, memory 80, col.4, ln.3-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Jensen into view of Chang in

order to prevent the misidentification of a call may result in lost billing opportunities or expense deductions as suggested by Jensen at column 1, lines 50-55.

Regarding claim 2, Chang further teaches an unanswered call indicator for indicating when an incoming call is not answered as determined from the line state signal (see col.2, ln.47-55).

Regarding claim 4, Chang further teaches the memorization device is operable to memorize received numbers of the incoming calls (see col.2, ln.46-55).

Regarding claim 5, Jensen further teaches the memorization device is operable to memorize communication times of outgoing calls by determining time elapsed between two line state changes for each incoming call (see col.4, ln.3-25).

Regarding claim 6, Chang further teaches the memorization device is operable to memorize called numbers (see col.2, ln.56-67).

Regarding claim 7, Chang further teaches a called number detector for detecting numbers dialed on the telephone line, thereby memorizing call numbers dialed from other telephones on the telephone line (see col.2, ln.56-67).

Regarding claim 8, Jensen further teaches the called number tone detector is a DTMF decoder (see figure 1, DTMF decoder 20).

Regarding claim 9, Jensen further teaches a processor having a memory; and a device for receiving programming signals over the telephone line, the programming signal being downloaded to the memory of the processor; and wherein the processor is operable to restore the data as a function of the line state of the telephone line (see figure 1, processor 10, memory 80, col.7, ln.1-5, ln.35-55).

Regarding claim 12, Chang teach a telephone comprising (see figure 2, col.2, ln.39-41):

a memorization or indication device for memorizing or indicating data related to incoming and/or outgoing calls on a telephone line (see figure 2, memory 24, LCD 25, col.1, ln.30-36, col.2, ln.47-65);

a detector for outputting a line state signal (the host telephone go off-hook and display the answered on the LCD 25) of the telephone line to the memorization or indication device (see figure 2, FSK decoder 21, col.2, ln.47-67), and

wherein the memorization or indication device is operable to memorize or indicate the data as a function of the line state signal of the telephone line (the host telephone go off-hook, on-hook, and display the answered on the LCD 25), thereby providing reliable data (read on caller ID) even when calls originate or terminate from or on another telephone on the telephone line (see col.2, ln.47-55).

It should be noticed that Chang fails to teach the line state of the telephone is either a busy state or a free state, wherein the memorization device is operable to memorize communication times of outgoing calls by determining time elapsed between two line state changes for each outgoing call. However, Jensen teaches the line state of the telephone is either a busy state or a free state (read on off-hook or on-hook, col.3, ln.10-16), wherein the memorization device is operable to memorize communication times of outgoing calls by determining time elapsed between two line state changes for each outgoing call (see figure 2, memory 80, col.4, ln.3-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Jensen into view of Chang in order to prevent the misidentification of a call may result in lost billing opportunities or expense deductions as suggested by Jensen at column 1, lines 50-55.

Regarding claim 13, Chang further teaches an unanswered call indicator for indicating when an incoming call is not answered as determined from the line state signal (see col.2, ln.47-55).

Regarding claim 14, Jensen further teaches the memorization or indication device is operable to memorize communication times of incoming calls by determining time elapsed between two line state (read on off-hook or on-hook) changes for each incoming call (see col.4, ln.3-35).

Regarding claim 15, Chang further teaches the memorization or indication device is operable to memorize received numbers of the incoming calls (see figure 2, memory 24, store the telephone number of incoming call, col.2, ln.50-52).

Regarding claim 16, Chang further teaches the memorization or indication device is operable to memorize called numbers (read on outgoing number)(see figure 2, memory 24, store the outgoing call number, col.6, ln.14-17).

Regarding claim 17, Chang further teaches a called number detector for detect numbers dialed on the telephone line (detect outgoing call), thereby memorizing call numbers dialed from other telephones on the telephone line (see figure 2, DTMF decoder 27, col.2, ln.47-55, col.3, ln.1-12).

Regarding claim 18, Chang further teaches DTMF decoder (see figure 2, DTMF decoder 27).

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan A. Pham whose telephone number is (571) 272-8097. The examiner can normally be reached on Monday through Friday, 8:30 AM-5:30 PM.

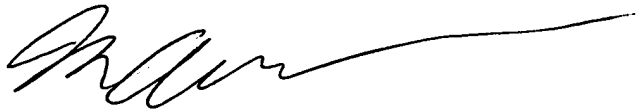
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Anderson can be reached on (571) 272-4177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2643

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have question on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit 2618
March 10, 2006
Examiner

Tuan Pham



Matthew Anderson
SPE 2618